

# Notice of Allowability

Application No.

09/941,279

Examiner

Callie E. Shosho

Applicant(s)

SCHLIESMAN ET AL.

Art Unit

1714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to amendment and declaration filed 8/11/03.
2. ☒ The allowed claim(s) is/are 1,2,4-10,13-26 and 28-31.
3. ☐ The drawings filed on \_\_\_\_\_ are accepted by the Examiner.
4. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) ☐ All b) ☐ Some\* c) ☐ None of the:
    1. ☐ Certified copies of the priority documents have been received.
    2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).
  - \* Certified copies not received: \_\_\_\_\_.
5. ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
  - (a) ☐ The translation of the foreign language provisional application has been received.
6. ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application. **THIS THREE-MONTH PERIOD IS NOT EXTENDABLE**

7. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
8. ☐ CORRECTED DRAWINGS must be submitted.
  - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
    - 1) ☐ hereto or 2) ☐ to Paper No. \_\_\_\_\_.
  - (b) ☐ including changes required by the proposed drawing correction filed \_\_\_\_\_, which has been approved by the Examiner.
  - (c) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No. \_\_\_\_\_.

Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet.

9. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

## Attachment(s)

- |   |   |
|---|---|
| 1 <input type="checkbox"/> Notice of References Cited (PTO-892)   | 2 <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)          |
| 3 <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                           | 4 <input type="checkbox"/> Interview Summary (PTO-413), Paper No. _____             |
| 5 <input checked="" type="checkbox"/> Information Disclosure Statements (PTO-1449), Paper No. <u>10/16/01</u> | 6 <input checked="" type="checkbox"/> Examiner's Amendment/Comment                  |
| 7 <input type="checkbox"/> Examiner's Comment Regarding Requirement for Deposit of Biological Material        | 8 <input checked="" type="checkbox"/> Examiner's Statement of Reasons for Allowance |
|   | 9 <input type="checkbox"/> Other  |

**Examiner's Amendment**

1. An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

(1) In the specification, page 1, line 3, after "August 21, 2000," and before "which", insert "now abandoned,".

(2) In the specification, page 1, line 4, after "1998," and before "which", insert "now U.S. Patent No. 6,140,406,".

**Statement of Reasons for Allowance**

2. The present claims are allowable over the "closest" prior art Fukushima et al. (U.S. 5,725,946) and Ohmori et al. (U.S. 5,279,885) for the following reasons:

(a) Fukushima et al. disclose method of making aqueous coating composition which has pH of 5.5-7.5 wherein the method comprises mixing pigment including silica gel, aqueous binder such as polyvinyl alcohol, sizing agent such as styrene-acrylic resin, and cationic fixing agent such as quaternary ammonium polymer.

However, with respect to present claims 1, 28, and 29, it is noted that there is no explicit disclosure that the coating composition has solids content of at least 30% as presently claimed. Further, as set forth in paragraph 5 of the 1.132 declaration filed 8/11/03, it is calculated from example 1 of Fukushima et al. that the coating composition comprises 13% solids which is outside the scope of the present claims. It is noted that it is further calculated that each of the coating compositions of examples 2-5 of Fukushima et al. have solids content of approximately 12-13% which falls outside the scope of the present claims 1, 28, and 29 which each require solids content of at least 30%. Further, as noted in paragraph 5 of the declaration, Fukushima et al. disclose that the coating composition is coated onto paper at coat weight which is consistent with a low solids coating composition.

With respect to present claims 13 and 24, it is noted that Fukushima et al. disclose method of making coating composition which comprises dispersing silica into water and blending this dispersion with the binder, sizing agent, and cationic polymer. There is no disclosure or suggestion in Fukushima et al. of method for making a coating composition comprising the sequential steps as required in present claims 13 or 24. Further, as set forth in

paragraphs 8 and 9 of the declaration filed 8/11/03, given that Fukushima et al. do disclose low solids coating composition as described in the preceding paragraph, the order of mixing the ingredients is less important. Only when coating composition has high solids content as presently claimed is the order of mixing important.

(b) Ohmori et al. disclose method of making coating composition comprising mixing pigment, binder, cationic fixing agent, and sizing agent.

However, there is no disclosure or suggestion in Ohmori et al. that the coating composition has solids content of at least 30% as required in present claims 1, 28, and 29 or any disclosure that the coating composition is substantially free of grit as required in present claim 1.

Further, there is no disclosure or suggestion in Ohmori et al. of method for making a coating composition comprising the sequential steps as required in present claims 13 or 24.

Thus, it is clear that Fukushima et al. or Ohmori et al., either alone or in combination, do not disclose or suggest the present invention.

Further, applicants' amendment and 1.132 declaration each filed 8/11/03 overcome the 35 USC 112 rejections of record.

In light of the above, it is clear that the rejections of record are untenable and so, the present claims are passed to issue.

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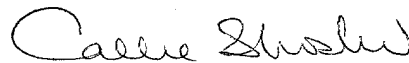
**NOTE:** A copy of the IDS filed 10/16/01, which was initialed, dated, and attached to the office action mailed 4/3/03, is attached to this present office action so that the examiner could insert, and thus make of record, dates for the references cited on page 4 of the IDS.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Callie E. Shosho whose telephone number is 703-305-0208. The examiner can normally be reached on Monday-Friday (6:30-4:00) Alternate Fridays Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 703-306-2777. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.



Callie E. Shosho  
Primary Examiner  
Art Unit 1714

CS  
9/20/03